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| APPLICATION NO.                                    | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 09/650,801   | 08/30/2000  | Peter J. Potrebic    | 14531.77                | 1181             |
| 22913  | 7590        | 03/30/2004           | EXAMINER                |                  |
| WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) |             |                      | VENT, JAMIE J           |                  |
| 60 EAST SOUTH TEMPLE                               |             |                      | ART UNIT                | PAPER NUMBER     |
| 1000 EAGLE GATE TOWER                              |             |                      | 2613                    | 6                |
| SALT LAKE CITY, UT 84111                           |             |                      | DATE MAILED: 03/30/2004 |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/650,801

Applicant(s)

POTREBIC ET AL.

Examiner

Jamie Vent

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5 - 09/05/2003
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-33 rejected under 35 U.S.C. 102(b) as being unpatentable by Vallone et al (US 6,642,939).

#### **[claim 1]**

In regard to Claim 1, Vallone et al discloses a system that includes a recording apparatus, a method for controlling the recording apparatus in response to programs that have been selected for recording and that have been selected for recording and that have coinciding broadcast times, the method comprising the acts of:

- Receiving user input selecting a first program for recording, the first program having a first broadcast time (Figure 14 shows how the user inputs desired selection while Figure 17 shows the selection of the first program by the user);
- Programming the recording apparatus to record the first program at the first broadcast time (Figure 17 shows the interface shown to the user when selection of recording a program is selected while Figure 1 shows the basic programming of the recording apparatus);

- Receiving user input selecting a second program for recording, the second program having a second broadcast time that at least partially coincides with the first broadcast time and determining that a conflict exists between the first program and the second program and storing, at the system, information specifying that the user has selected both the first and second program to be recorded (Figure 25 shows the receiving of the user input as well as the system recognizing a conflict exists between the two programs).

**[claim 2]**

In regard to Claim 2, Vallone et al discloses a method further comprising the act of communicating to the user information specifying that the conflict exists and that the second program is to be recorded only if the conflict is resolved prior to the second broadcast time (Figure 25 shows that the second program is to be recorded only if the conflict is resolved by allowing the user to select "OK, cancel the other recording" thereby allowing the second program to be recorded.

**[claim 3]**

In regard to Claim 3, Vallone et al further discloses the act of receiving no further user input in response to the act of communicating, such that the information specifying that the user has selected both the first program and the second program to be recorded remains stored at the system (Figure 25 shows that the second program will be saved since it over-rides the first program).

**[claims 4, 5, & 6]**

In regard to Claims 4, 5, and 6, Vallone et al discloses the following acts:

- After determining the conflict exists, determining that the conflict has been resolved (Figure 24 shows what is to be recorded when no conflicts exists);
- Programming the recording apparatus to record the second program at the second broadcast time (Figure 28 shows the option of programming the recording apparatus for a second program at a second program time element 2813);
- Determining that the conflict has been resolved is conducted in response to the first program having been preempted such that the first program is not broadcast at the first broadcast time (Figure 24 would show that the first program has been preempted and is not broadcast at the first broadcast time);
- Determining that the conflict has been resolved is conducted in response to an additional tuner being made available at the system, such that both the first program and the second program can be recorded simultaneously.(Figure 2 element 201-204 are available tuners able to record programs from various input sources thereby resolving conflict).

**[claims 7 & 8]**

In regard to Claims 7 and 8, Vallone et al discloses a method wherein the act of determining the conflict has been resolved is:

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- Conducted in response to at least one of a start time and an end time of at least one of the first program and the second program changing from that which was scheduled, such that no portion of the first program coincides with any portion of the second program (Figure 27 shows the play bar that indicates if a recording is in progress. The timing is marked by marks of 15 minutes as seen on the bar);
- Comprised of the act of analyzing broadcast data broadcast on a channel that includes one of the first program and the second program, the broadcast data identifying said at least one of the start time and the end time of said at least one of the first program and the second program (Figure 32 shows the broadcast data identifying start and end time of the programs).

**[claims 9 &10]**

In regard to Claims 9 and 10, Vallone et al discloses a methods comprising:

- determining that an episode of the second program to be shown at the second program to be shown at the second broadcast time is also to be shown at another broadcast time that does not conflict with the first broadcast time, thereby resolving the conflict (Figure 25 shows the conflict screen but the user can select to get to Figure 32 to determine a new time for recording and will be instructed to record. If programming for recording is successful it is seen that no conflicts continue to exists);

- User input selecting the first program for recording specifies that the recording of the first program is optional and is to be overridden by a subsequent selection of a conflicting program (Figure 19 allows for the user to have options regarding recording); and
- Act of receiving user input selecting the second program is conducted after the act of receiving user input selecting the first program, such that the second program is scheduled to be recorded rather than the first program (Figure 25 shows the second program to be recorded over the first).

**[claim 11]**

In regard to Claim 11, Vallone et al discloses the method for resolving a conflict between programs, as stated in Claim 1, with the additional limitations:

- Automatically determining that said episode of the second program also has another showing at another broadcast time that does not coincide with the first broadcast time (Figure 19 element 1905 allows for user to see upcoming showings/broadcast times of the desired recorded programs);
- Programming the recording apparatus to record the first program at the first broadcast time and said other showing of the episode of the second program at the said other broadcast time (Figure 24 shows a list of items to be recorded by the apparatus).

**[claims 12 &13]**

In regard to Claims 12 and 13, Vallone et al discloses the following methods of:

- automatically determining that said episode of the second program also has another showing comprises the act of analyzing data associated with an electronic program guide at the system (Figure 19 shows the menu for allowing the user to select to see times of upcoming showings that are associated by EPG data pages (Column 13 Lines 18+)); and
- analyzing data associated with an electronic program guide comprises the act of finding a program listing associated with said other showing by determining that a program identifier included in said program listing associated with said other showing matches a program identifier included in a program listing associated with said showing of said episode of said second program (Column 14 Lines 10+ describes analyzing data with an electronic program guide data while the program identifier is included in the program list of the finding the second program as seen in the result of Figure 32).

**[claims 14 & 15]**

In regard to Claims 14 and 15, Vallone et al discloses the following methods of:

- communicating to the user information indicating that said other showing of the episode of the second program is to be recorded at said other broadcast time (Figure 19 shows the recording broadcast time) .
- The other showing of the episode of the second program is to be broadcast on a channel from the channel on which said selected showing of the episode is to be broadcast (Figure 32 shows a program to be



broadcasted on the channel as well as time for the selected episode of a broadcast).

**[claim 16]**

In regard to Claim 16, Vallone et al discloses a system that includes a recording apparatus, a method for resolving conflicts between the programs that have been selected for recording and have coinciding broadcast times, at least one of the programs being a repeating program, the method comprising the act of:

- Receiving input selecting a repeating first program to be recorded on a repetitive basis (Figure 19 element 1904 "Get a Season Pass" allows for recording on a repetitive basis);
- Receiving input selecting a second program for recording, the second program having a broadcast time that at least partially coincides with at least one showing of the repeating first program but does not coincide with other showings of the repeating first program (Figure 24 shows the selecting of programs while Figure 25 would show the conflict between the two programs); and
- Programming the recording apparatus to record the second program and to record the showing of the repeating first program on a repetitive basis, except for said at least one showing of the repeating first program with which the second program at least partially coincides (Figure 24 shows the recording programs).

**[claim 17]**

In regard to Claim 17, Vallone et al discloses a method wherein:

- The act of receiving input selecting the repeating first program is conducted prior to the act of receiving input selecting the second program (Figure 2 shows the receiving of input signals through the various tuners while one program is received prior to receiving the second program through that tuner while Figure 17 shows multiple programs that can be received);
- Prior to the act of receiving input selecting the second program, the act of provisionally programming the recording apparatus to record all showings of the repeating first program (Figure 17 shows the selection of the first program thereby programming the recording apparatus to record all showings as further illustrated in Figure 19); and
- Act of programming the recording apparatus comprises the act of modifying the provisional programming of the recording apparatus to specify that said at least one showing of the repeating first program is not to be recorded (Figure 19 shows the ability to record one episode or to cancel the recording of that episode).

**[claims 18, 19, 20, & 21]**

In regard to Claims 18, 19, 20, and 21, Vallone et al discloses the following methods:

- Act of receiving input selecting the repeating first program is conducted after the act of receiving input selecting the second program (Figure 2 shows the receiving of input signals through the various tuners while one

program is received prior to receiving the second program through that tuner while Figure 17 shows multiple programs that can be received);

- Act of programming the recording apparatus is conducted without receiving user input specifically indicating that said at least one showing of the repeating first program with which the second program at least partially coincides is not to be recorded (Figure 25 shows the conflict prompted to user; however, if user does not select an action to do the recording apparatus will record the second program if it partially coincides);
- Second program is a non-repeating program (Figure 17 shows various programs that are repeating and non-repeating); and
- Second program is a repeating program that has a frequency less than the frequency of the repeating first program (Figure 19 shows the frequency of repeating times each program will be aired through the view upcoming showings selection).

**[claim 22]**

In regard to Claim 22, Vallone et al discloses a system that includes a recording apparatus, a method for resolving conflicts between programs that have been selected for recording and have coinciding broadcast times, the method comprising the acts of:

- Receiving input selecting a second program for recording, the second program having an expected second broadcast time having an expected start time and an expected end time (Figure 18 shows selection of the

program the start time and the duration thereby showing the expected end time);

- Monitoring broadcast data on a channel on which the second program is to be broadcast to determine that at least one of an actual start time and an actual end time differs from the respective expected start time and expected end time (Figure 17 will monitor the broadcast making sure the actual start time and actual end time matches the estimated); and
- Based on the act of monitoring the broadcast data, determining whether both the first program and the second program can be recorded, and, if so, recording both the first program and the second program using the recording apparatus (Figure 25 will show a conflict if both can not be recorded due to start and end times).

**[claims 23 & 24]**

In regard to Claims 23 and 24, Vallone et al discloses the first broadcast time does not coincide with the expected second broadcast time and the first broadcast time at least partially coincides with an actual second broadcast time defined by the actual start time and the actual end time such that:

- Act of determining whether both the first program and the second program can be recorded results in a determination that one of the first program and the second program can not be recorded (Figure 25 will show a conflict if both can not be recorded due to start and end times);

- Act of recording all of the second program during the actual second broadcast time as opposed to recording only that portion of the second program that is broadcast during the expected second broadcast time (Figure 25 further options with this screen will allow recording of the second broadcast time as opposed to only a portion of the current broadcast time).

**[claim 25]**

In regard to Claim 25, Vallone et al discloses a method wherein the first broadcast time at least partially coincides with the expected second broadcast time and the first broadcast time does not coincide with an actual second broadcast time defined by the actual start time and the actual end time, such that:

- Conflict between the first broadcast time and the expected second broadcast time is resolved and both the first program and the second programs are recorded (Figure 24 shows a list of programs where both first and second programs are recorded with no conflicts).

**[claim 26]**

In regard to Claim 26, Vallone et al discloses a system that includes a recording apparatus and an electronic program guide, a method for responding to dynamic conditions associated with the system so as to identify programs to be recorded after a conflict between selected programs is resolved, the method comprising:

- User input selecting a first program for recording, programming the recording apparatus to record the first program at a first broadcast time

using the electronic program guide (Figure 18 information gathered from an electronic program guide and user selects to record via element 1804);

- Receiving user input selecting a second program for recording, the second program having a second broadcast time that at least partially coincides with the first broadcast time (Figure 19 receives request to select and record another program different than that of Figure 18);
- Determining that a conflict exists between the first program and the second program, such that the second program is not to be recorded unless the conflict is resolved (Figure 25 shows that conflict exists between two programs with conflicting times);
- Storing at the system information specifying that the user has selected the second program for recording (Figure 25 user chooses the "OK, cancel the other recording the second program will be recorded); then
- In response to the conflict between the first program and the second program being resolved, automatically programming the recording apparatus to record the second program (Figure 25); and
- Recording the second program using the recording apparatus (Figure 1).

**[claim 27, 28, 29, 30, & 31]**

In regard to Claims 27, 28, 29, 30, and 31 Vallone et al discloses the method wherein conflicts are resolved upon:

- the system receiving user input deselecting the first program (Figure 25 "Don't record this program" deselects the first program);

- an additional tuner being made available at the system, such that both the first program and the second program can be recorded simultaneously (Figure 2 elements 201-204);
- the first program being preempted such that the first program is not broadcast at the first broadcast time (Figure 19);
- at least one of a start time and an end time of at least one of the first program and the second program changing from that which was scheduled, such that no portion of the first program coincides with any portion of the second program (Figure 25 if timing changes the result will be the conflict screen); and
- system performing the act of determining that an episode of the second program to be shown at the second broadcast time is also to be shown at another broadcast time that does not conflict with the first broadcast time, the act of automatically programming the recording apparatus to record the second program comprising the act of programming the recording apparatus to record the second program at said other broadcast time (Figure 32 shows other broadcasting times while Figure 25 shows conflict when occurring).

**[claims 32 & 33]**

In regard to claims 32 and 33, Vallone et al discloses the method further comprises the acts of:

- prior to the conflict being resolved, receiving user input selecting a third program for recording at a third broadcast time (Figure 17 n amount of shows can be selected for recording); and
- prior to the act of programming the recording apparatus to record the second program and after the conflict is resolved, reconsidering which of the selected programs, including the second program and the third program, are to be recorded, using a priority list that lists the programs in an original order in which the selected programs were selected or using a priority list that lists the selected programs first by whether the recording apparatus was originally programmed to record the selected programs and second in an original order in which the selected programs were selected (Figure 24 shows the priority listing and what programs are to be selected and recorded at appropriate times and channels.)

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following is considered of significant interest to the application:

- Yoshinobu et al US 5,686,954);
- Nagano et al (US 6,240,240); and
- Yuen et al (5,307,173).




Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Vent whose telephone number is 703-305-0378. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 703-305-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JV

Miss Jamie J Vent

  
CHRIS KELLEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600